THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte PAUL R. KRISTOFF,
DAVID P. NUNN,
CHRISTOPHER WINEMILLER,
DENNIS L. DRAHEIM,
JOHN McCOLLUM,
JUDITH S. HIRSCH,
JOHN H. McGEHEE, and
ROBERT J. WHITE, JR.

_____

Appeal No. 1997-0921
Application 08/038,577[1]

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ON BRIEF[2]

_____

Before THOMAS, RUGGIERO, and GROSS, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

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[1] Application for Patent filed March 29, 1993.

[2] The oral hearing scheduled for January 10, 2000, has been waived in a letter received on December 16, 1999.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1 through 9, which constitute all the claims in the application.

Representative claim 9 is reproduced below:

9. An apparatus for generating a plurality of process steps to form a sequence of steps corresponding to a plurality of levels to operate a machine, comprising:

circuitry for obtaining a pointer from a database corresponding to said sequence of the steps;

circuitry for defining the sequence into at least two portions including a first portion and a second portion; and

circuitry for generating said process steps from said pointer so that said process steps include a first process step corresponding to first steps of said first portion of said two portions and not corresponding to second steps of said second portion of said two portions, and a second process step corresponding to said second steps of said second portion of said two portions and not corresponding to said first steps of said first portion of said sequence.

There are no references relied on by the examiner.

Claims 1 through 9 stand rejected under the first paragraph of 35 U.S.C. § 112 as being based upon a nonenabling disclosure. Claims 1 through 9 also stand rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite.

Rather than repeat the positions of the appellants and the examiner, reference is made to the briefs and the answer for the respective details thereof.

OPINION

We reverse both rejections.

As to the enablement issue, the specification of the patent must teach those skilled in the art how to make and use the claimed invention without undue experimentation. Genentech, Inc. v. Novo Nordisk A/S, 108 F.3d 1361, 1365, 42 USPQ2d 1001, 1004 (Fed. Cir.), cert. denied, 118 S. Ct. 397 (1997). This same case indicates that the scope of the claims must bear a reasonable correlation to the scope of enablement provided by the disclosure. Enablement is also not precluded even if some experimentation is necessary, although the amount of experimentation needed must not be unduly excessive. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987). For purposes of the present disclosed and claimed invention, the person of ordinary skill in the art or artisan appears to be one familiar with database organization and management in computerized systems, particularly those related to object-oriented databases (OODB), and computer aided machine process design. Note In re Naquin, 398 F.2d 863, 866, 158 USPQ 317, 319 (CCPA 1968) and In re Brown, 477 F.2d 946, 950, 177 USPQ 691, 694 (CCPA 1973).

Independent claims 1 and 9 on appeal are respective method and apparatus versions which recite essentially the same subject matter in the respective statutory classes. Claim 6 is substantially identical as a method claim to that subject matter set forth

in method claim 1 on appeal except for the last or generating clause. In any case, all claims on appeal relate the body of the claim to the preamble. That is to say, the plurality of process steps to form a sequence of steps in the preamble of each of the three independent claims on appeal directly are related to and recited in the body of the claims in more specific manners in the context of a database and the sequencing of the steps associated therewith to generate the process steps ultimately "to operate a machine" as set forth in the preamble.

A study of the written specification and the Figures reveals that they are less integrated and explained as we would prefer to see. What is significant to us, however, is that the specification is written from the perspective of an artisan as defined earlier at a relatively high level of understanding or abstraction. This, we believe, the examiner has not appreciated in reaching the decision to reject the claims on appeal under two bases of 35 U.S.C. § 112. The specification is written from the perspective of an object oriented database or OODB and from the further perspective of disclosing a generic manner in which changes to a methodology of sequencing the various steps of manufacturing in producing a product may be explained. A broadly depicted OODB management system is shown in Figure 3 where the claimed machine to be controlled and the sequence of steps listed to control it are shown to be embodied in the machine processor 610 of Figure 4. With respect to the claimed pointer, it is noted originally at page 3 of the specification that an object may comprise only a set of pointers to data in the context of an OODB; it is also

discussed in the specification at the top of page 16, for example. The claimed levels in the preamble of the independent claims on appeal are discussed initially at the middle of page 5, the top of page 6, the objects of the invention at the middle of page 8, and at least at the middle of page 13, for example. Note also the depiction of the various levels in Figure 1. With respect to the generating step and clause of claims 1 and 9 on appeal, the discussion of the operation of Figures 10 and 11 at pages 16 and 17 appear to be most pertinent. Similarly, as to the generating step of independent claim 6 on appeal, the discussion with respect to the parameter values at pages 18 and 19 appear to be most pertinent. Finally, we observe that a detailed study of the specification and drawings as filed also reveals to the reader the feature of obtaining flow from a pointer in dependent claim 2, obtaining a body corresponding to that flow in claim 3, obtaining procedure calls of claim 4 and additional bodies in claim 5, the discussion of lexical scoping in claim 7, and the overwriting of default values in claim 8.

Although the specification is written in a rather abstract, concept-oriented manner, it is addressed to the artisan as the artisan was defined earlier. We conclude, therefore, that the artisan would have been enabled to make and use the presently claimed invention with only a routine degree and certainly not an undue amount of experimentation to make and use the presently claimed invention. It is clear from the subject matter of the claims on appeal that a database environment is required even though the specific type disclosed, OODB, is not specifically recited in the claims. From an artisan's perspective the teaching

value of the specification would have been such as to have indicated to the artisan reasonable correlations to other types of databases, such that the scope of enablement would have been reasonably sufficient to the artisan within 35 U.S.C. § 112, first paragraph. As such, we must reverse the rejection of claims 1 through 9 under the enablement portion of the first paragraph of
35 U.S.C. § 112.

Turning to the rejection of claims 1 to 9 under the second paragraph of 35 U.S.C. § 112, it is to be noted that to comply with the requirements of the cited paragraph, a claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure and the teachings of the prior art as it would be by the artisan. Note In re Johnson, 558 F.2d 1008, 1016, 194 USPQ 187, 194 (CCPA 1977); In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

We have reviewed and considered the examiner's reasons in support of the rejection, but are not convinced that the cited claims fail to comply with the second paragraph of 35 U.S.C. § 112. At the outset, we note that the breadth of the claims is not equated with indefiniteness of the claims. See In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971). It is perfectly permissible for appellant to claim his invention in terms as broad as his application disclosure will support.

Without belaboring the issue, it is apparent from our earlier discussion that there is a relatively clear correspondence of the terminology and functions associated therewith in each of the claims on appeal to that which has been disclosed in the specification as filed. Therefore, it is relatively straightforward to conclude that the appellants are particularly pointing out and distinctly claiming what they have regarded as their invention within the second paragraph of 35 U.S.C. § 112. As such, the claims are not indefinite. Additionally, the scope associated with each of the features recited is consistent with the scope of disclosure. As just noted in the preceding paragraph, it is improper to associate or equate breadth of the claims with indefiniteness. We therefore do not agree with the examiner's assertion at pages 5 and 6 of the Answer that the claims require such a large amount of speculation as to what is being claimed to justify the examiner's conclusion that no art rejection has therefore been applied in accordance with In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). Therefore, we must reverse the rejection of claims 1 through 9 under the second paragraph of 35 U.S.C. § 112.

In conclusion, we have reversed both rejections of claims 1 through 9 under the first and second paragraphs of 35 U.S.C. § 112. The decision of the examiner is reversed.

REVERSED

JAMES D. THOMAS Administrative Patent Judge	)
JOSEPH F. RUGGIERO Administrative Patent Judge	) BOARD OF PATENT)) APPEALS AND)) INTERFERENCES
ANITA PELLMAN GROSS Administrative Patent Judge	)

JDT/dem

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